

REMARKS

Claims 18-21 are pending. Claim 18 is amended. No new matter is submitted. Accordingly, entry and consideration of the amendment is respectfully requested.

Should the Examiner determine that the amendments made herein do not place this application in condition for allowance, it is nonetheless respectfully requested that the amendments be entered in order to place the claims in better form for consideration on appeal in the event an appeal is pursued.

In the Office Action, claims 18 and 19 are rejected under 35 U.S.C. 102(b) as allegedly anticipated by U.S. Patent No. 5,460,629 to Shlain, et al. (hereafter "Shlain"). The rejection is respectfully traversed.

To maintain a 35 U.S.C. 102(b) rejection, a reference must teach each and every element of a claimed invention. Shlain does not do so.

Applicants' invention with respect to claim 18 comprises a surgical device for severing tissue having, *inter alia*, a shaft, a hook member at a distal end of the shaft configured to capture a vessel, a sliding member having a movable cutting blade housed therein, and at least one electrode, separate from the hook member and the cutting blade, for cauterizing a captured vessel. The movable cutting blade deploys from the sliding member to cut a vessel captured between the hook member and the cutting blade (Specification, page 11, lines 11-16), while the at least one electrode cauterizes the vessel. Claim 19 depends directly from claim 18.

Shlain discloses an electrosurgical probe 10 having a hook 22 at a distal end thereof and a movable forked paddle 36 straddling either side of the hook. The forked paddle 36 of Shlain has no movable cutting blade housed therein as recited in claim 18 of Applicants' invention. Moreover, the various electrode configurations of Shlain Figs. 9-21 fail to disclose the combination of a hook member, a sliding member movable with respect to the hook member and a cutting blade housed within the sliding member, and at least one electrode *separate from*

the hook and the cutting blade as recited in claim 18. Instead electrodes comprise one or the other of the various hook members or the forked paddle of Shlain (Figs. 9-21B). Even in Figs. 21A-21B, wherein the blade 132 nests within the hook member 136, the hook member 136 is an electrode and the blade 132 is an electrode (col. 9, lines 36-46). Shlain thus fails to teach or disclose each and every element of the claimed invention with respect to claims 18. Claim 19 depends directly from claim 18. Accordingly, withdrawal of the 35 U.S.C. 102(b) rejection of claims 18 and 19 based on Shlain is respectfully requested.

Moreover, with respect to the Response to Arguments section of the Office Action, Applicant asserts that the recitation of the “movable cutting blade housed therein” the sliding member of claim 18, structurally distinguishes over Shlain and thus renders moot any intended use rationales set forth in the Office Action as Shlain does not disclose the movable cutting blade contemplated by claim 18. Still further, with respect to the Response to Arguments section of the Office Action, Applicants assert that the use of electrodes in Shlain are for shearing tissue (col. 7, lines 23-30) and not for ligating or cauterizing a vessel as in Applicants invention, are optionally used in any event, referring to Fig. 9, wherein the cone electrode 50 of Shlain may be used in lieu of the needle 54 when the needle 54 is retracted (col. 8, lines 39-42), and are not provided separate from the hook member and cutting blade as recited in claim 18.

In the Office Action, claims 18, 20 and 21 are also rejected under 35 U.S.C. 102(b) as allegedly anticipated by U.S. Patent No. 5,397,333 to Knoepfler (hereafter “Knoepfler”). The rejection is respectfully traversed.

As before, to maintain a 35 U.S.C. 102(b) rejection a reference must teach each and every element of a claim. Knoepfler does not do so.

Applicants’ invention with respect to claim 18 is discussed above and comprises, *inter alia*, a surgical device for severing tissue including a sliding member movable with respect

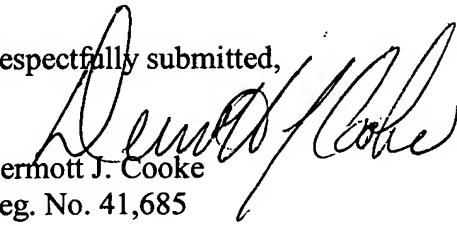
to the hook member. Applicants' invention with respect to claim 21 comprises, *inter alia*, a surgical device for severing tissue including a plunger movable relative to a hook member.

Knoepfler discloses a hook knife 10 having a tip 22 wherein the hook knife 10 is attached to a movable blade support 34 by positioning a slot 24 of the hook knife 10 over a raised portion 32 of the blade support 34. Once positioned on the blade support 34, the hook knife 10 moves *with* the tip 22 to cut tissue, rather than moving "with respect to" or "relative to" the hook member as recited in claims 18 and 21, respectively. Knoepfler also discloses a hook knife 10' having a tip 22', wherein the hook knife 10' is similarly attached to a blade support 34'. In this latter instance, the hook knife 10' is attached to the blade support 34' between slots 37a, 37b of flanges 38a, 38b. Once attached to the blade support 34', the hook knife 10' moves *with* the tip 22' in order to cut tissue, rather than moving "with respect to" or "relative to" the hook member as recited in claims 18 and 21. The arrangement of the sliding member movable with respect to the hook member of claim 18, and the arrangement of the plunger movable relative to the hook member of claim 21 are not mere intended use features of the respective claims as alleged in the Response to Arguments section of the Office Action with respect to Knoepfler, but are structural differences that distinguish over Knoepfler. Claim 20 depends from claim 18. Accordingly, withdrawal of the 35 U.S.C. 102(b) rejection of claims 18, 20 and 21 based on Knoepfler is respectfully requested.

Should the Examiner determine that anything further is desirable to place this application in even better form for Allowance, the Examiner is invited to contact the undersigned at the telephone number indicated below.

Respectfully submitted,

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